



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,477	04/20/2001	Lorin R. Debonte	07148-094001 / A15-502	2474

26191 7590 06/03/2003

FISH & RICHARDSON P.C.
3300 DAIN RAUSCHER PLAZA
60 SOUTH SIXTH STREET
MINNEAPOLIS, MN 55402

EXAMINER

MCELWAIN, ELIZABETH F

ART UNIT	PAPER NUMBER
----------	--------------

1638

DATE MAILED: 06/03/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/839,477

Applicant(s)

DEBONTE ET AL.

Examiner

Elizabeth F. McElwain

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 19-23 and 31-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 19-23 and 31-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

The amendment filed March 4, 2003 has been entered.

Claims 2, 17, 33 and 34 are newly submitted.

Claims 13-16, 18, 24-30 and 36-39 have been cancelled.

Claims 1-12, 17, 19-23 and 31-35 are pending and are examined.

5 Rejections that have not been restated have been withdrawn.

The text of those sections of Title 35, U.S. Code not included in this action can be found
in a prior Office action.

10 Claims 1-12, 17, 19-23 and 31-35 are rejected under 35 U.S.C. 103(a) as being obvious
over Ohlrogge et al (U.S. Patent 5,925,805) taken with Shorosh et al (PNAS 91:4323-4327, May
1994) and in view of Gegenbach et al (U.S. Patent 5,498,544), as stated in the last office action
for claims 1-39.

15 Applicant's arguments filed March 4, 2003 have been fully considered but they are not
persuasive.

20 Applicants argue that the rejection is improper given that one would not expect that a
statistically significant increase in oil content could be achieved in a plant in the absence of a
transit peptide directing the ACCase polypeptide into the plastid, given that fatty acid synthesis
occurs in the plastid. In addition, Applicants state that Ohlrogge et al disclose only a 5% increase
in oil content in seeds from plants transgenic for an ACCase construct containing a transit
peptide. Therefore, applicants assert that one of ordinary skill in the art would not have had a

reasonable expectation of success and it would not have been obvious to one of ordinary skill in the art that a significant increase of 5% to 25% could be reached using an ACCase construct that lacks a transit peptide. Applicants further state that while Gegenbach et al disclose that a transit peptide is optional in a construct expressing an ACCase sequence and they predict a broad range of oil content for plants transformed with said construct, that Gegenbach et al do not exemplify a plant or method of making a plant with a high oil content. Thus, applicants argue that the rejection is based on an "obvious to try" standard. In addition, applicants assert that the predictions of Gegenbach are not in agreement with the results of Ohlrogge et al, and the cited references, in combination, do not provide a reasonable expectation of success of producing plants that exhibit a 5% to 25% increase in oil content using an ACCase construct lacking a transit peptide.

The Examiner maintains the rejection given that at page 19, lines 12-13 of the specification it is disclosed that plants transformed with the -7ACCase construct (the full length ACCase coding sequence without a transit peptide) had fatty acid compositions that were not significantly different from the fatty acid profile of the Westar background variety. Only after many rounds of selection for increased oil was higher oil obtained. In addition, the only example provided is Brassica napus having an improved oil content after seven generations, wherein each subsequent generation was produced from the plants exhibiting the highest oil content.

Therefore, it would have been obvious to use the teachings of the cited references in combination to practice the claimed invention, in the absence of evidence to the contrary. In addition, an

increase of 5% is within the limits of 5% to 25% that is claimed, and the evidence for nonobviousness should be commensurate with the scope of the claims.

No claims are allowed.

5

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth F. McElwain whose telephone number is (703) 308-1794. The examiner can normally be reached on Monday through Friday from 8:00 AM to 4:30 PM.

20

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached at (703) 306-3218. The fax phone number for this Group is (703) 308-4242. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

25

Serial No. 09/839,477
Art Unit 1638

-5-

Any inquiry of a general nature or relating to the status of this application should be directed to the CUSTOMER SERVICE TECH CENTER 1600, whose telephone number is (703) 308-0198, or to the Group receptionist whose telephone number is (703) 308-0196.

5 Elizabeth F. McElwain, Ph.D.
May 30, 2003


ELIZABETH F. McELWAIN
PRIMARY EXAMINER
GROUP 1600